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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,465	08/14/2003	Marc Mathews		2164

7590

02/07/2006

Marc Mathews  
3920 MESCAL CIRCLE  
LINCOLN, NE 68516

EXAMINER
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COBURN, CORBETT B

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

<b>Office Action Summary</b>	<b>Application No.</b> 10/642,465	<b>Applicant(s)</b> MATHEWS, MARC	
	<b>Examiner</b> Corbett B. Coburn	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,869,359. Although the conflicting claims are not identical, they are not patentably distinct from each other because the primary difference between the two sets of claims in the indicia used. The indicia used in a game are a matter of aesthetic design choice.

***Drawings***

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings submitted are barely legible. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in

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reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4 & 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fey

(*Slot Machines, A Pictorial History of the First 100 Years*) in view of Stern (US 2002/0074725).

**Claims 1, 2, 4:** Fey teaches the Mills 1929 Baseball Vender (page 167). The Baseball Vender is a gaming apparatus with a sports theme – i.e., baseball. There is a plurality of independently and randomly selected symbols disposed in a rectangular positional array. Each of the symbols of said plurality is directly related to a single predetermined sport. (See the reel strip along the side of the page.) The outcome of a gaming sequence using said display is a function of the symbols displayed along the payline. The player places a bet on the payline prior to the beginning of the game. Fey does not teach that the rectangular array comprises four rows and four columns of windows or a plurality of individually selectable paylines respectively intersecting four rows, four columns and two diagonals of four symbols displayed in the windows of said array. Stern teaches a rectangular array comprising four rows and four columns of windows or a plurality of individually selectable paylines respectively intersecting four rows, four columns and two diagonals of four symbols displayed in the windows of said array. Providing larger

arrays of symbols with multiple paylines is extremely well known to the art. This allows players to bet on more propositions, thus increasing the handle (i.e., the profits) on the gaming machine. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Baseball Vender in view of Stern to include a rectangular array comprising four rows and four columns of windows or a plurality of individually selectable paylines respectively intersecting four rows, four columns and two diagonals of four symbols displayed in the windows of said array in order to provide more proposition upon which a player may bet, thus increasing profits. The existence of the game clearly implies the structure necessary to carry out the game.

**Claim 5:** Fey teaches enabling the gaming apparatus to play a bonus round of a gaming sequence in the event that a patron selects a predetermined payline, bets a predetermined amount of money on the payline, and receives a predetermined arrangement of predetermined symbols along the predetermined payline. A winning combination results in playing the bonus baseball game depicted on the front of the cabinet.

6. Claims 3 & 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fey in view of Stern as applied to claims 2 or 5 above, and further in view of Morro et al. (US Patent Number 6,162,121).

**Claims 3 & 6:** Fey and Stern teaches the invention substantially as claimed, but fails to teach a first, second and third display regions each of which include means for displaying a round of a predetermined table game thereon wherein the bonus round is a single play of one of three predetermined table games. Morro teaches a slot machine with a first, second and third display regions (i.e., 608A-C) each of which include means for

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displaying a round of a predetermined table game thereon wherein the bonus round is a single play of one of three predetermined table games. Morro discloses that having three wheels allows the casino to offer larger jackpots that attract more players. (Col 2, 47-60) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fey and Stern in view of Morro to include a first, second and third display regions each of which include means for displaying a round of a predetermined table game thereon wherein the bonus round is a single play of one of three predetermined table games in order to allow the casino to offer larger jackpots thus attracting more players.

### *Conclusion*

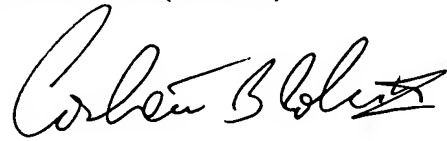
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baerlocher et al. (US Patent Number 6,413,162) teaches a square array of independent reels.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Jones can be reached on (571) 272-4438. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Corbett B. Coburn", with a stylized flourish at the end.

Corbett B. Coburn  
Examiner  
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